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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,665	10/03/2003	Thomas Rumpf	RUMPF ET AL-4	9747
Kurt Kelman COLLARD & ROE, P.C. 1077 Northern Boulevard Roslyn, NY 11576				
7590 04/10/2008				
EXAMINER				
OMCBA, ESSAMA				
ART UNIT		PAPER NUMBER		
3726				
MAIL DATE		DELIVERY MODE		
04/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/678,665

**Applicant(s)**

RUMPF ET AL.

**Examiner**

Essama Omgba

**Art Unit**

3726

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 15, 2008 has been entered.
2. The terminal disclaimer filed on February 15, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 7,178,238 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (US Patent 2,734,024) in view of Bank et al. (US Patent 6,312,579).

With regards to claims 2 and 4, Schultz teaches a method of producing a workpiece having at least one bearing eye (the figure), the surface of the bearing eye being coated with an anti-friction coating made of an alloy of a harder alloy component and a softer alloy component (col. 2, lines 20-22), wherein the bearing eye surface is

processed for a precise fit to a circular cylinder and the production is then finished without further processing by applying the anti-friction coating to the processed bearing eye surface in a thickness corresponding to the final dimensions (col. 2, lines 33-72 and column 3, lines 1-40. Although Schultz does not disclose the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness, however it is known to vary the thickness of the layers to suit a particular application as attested by Bank et al., see column 4, lines 49-51. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have increased the proportion of the softer alloy component in the deposited alloy of the Schultz method with increased coating thickness, as taught by Bank et al., in order to suit a particular application. Applicant should note that the anti-friction coating is galvanically deposited as taught by Bank et al., with the strength of the electrical field used for depositing being varied (col. 3, lines 44-52).

For claim 3, see column 3, lines 5-14 of Schultz.

### ***Response to Arguments***

5. Applicant's arguments filed November 15, 2007 have been fully considered but they are not persuasive.

In response to Applicant's argument that a work piece having a bearing eye which is directly coated with a gliding layer as recited in Applicant's claim 4 is nowhere disclosed or suggested in Schultz or Bank et al., the examiner submits that the recitation has not been given any patentable weight because the recitation occurs in the

preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to Applicant's argument that "a cutting (machining) for producing an exact circle form cylinder, as is done in Applicant's method as recited in claim 4 is neither purposeful for the methods taught by Schultz and Bank et al. nor provided in these references", the examiner submits that the features upon which Applicant relies (i.e., cutting (machining) to produce an exact cylinder) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Circ. 1993).

In response to Applicant's argument that neither Schultz by itself nor in combination with Bank et al. can render obvious Applicant's method as recited in claim 4, in that neither of these prior arts even concern themselves with the problem to which Applicant's invention as recited in claim 4 is directed, the examiner respectfully disagrees. As clearly disclosed by Bank et al. in column 1, Bank et al.'s process finds application in friction bearings subjected to high dynamic loads (bearings for use in high load applications for journaling crank shafts). Furthermore, just like in Applicant's invention, Bank et al. teaches a functional bearing layer produced from the same bath

so as to produce a multilayer by varying the current density during plating, see column 3, lines 29-52 of Bank et al.

In view of the above remarks, the examiner maintains that a *prima facie* case of obviousness has been established in the instant application.

### ***Conclusion***

6. This is a RCE of applicant's earlier Application No. 10/678,665. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Essama Omgba/  
Primary Examiner, Art Unit 3726

eo  
April 7, 2008